REMARKS

Claims 14, 40-42 and 44 have been amended. Claims 14, 19-28, 30 and 33-44 are pending and currently under examination in the application. Support for the amendments can be found in the specification and claims as filed, and at least at page 20, line 30 to page 21, line 17. Claims 40-42 and 44 have been amended to correspond to the amended claim 14. No new matter is added.

Claim 14 as currently amended reads:

> A delivery mixture comprising a delivery agent consisting of a generation 2 to 5 dendrimer mixed with an amount of a nucleic acid effective to mediate RNA interference (RNAi).

Rejections Withdrawn

The Applicant appreciates that the rejection of claims 14, 20, 22-24 and 43 under 35 U.S.C. §102(e) as being anticipated by Frecht et al. (U.S. Patent No. 7,097,856) is withdrawn.

Rejections Maintained

Claim Rejections - 35 USC § 102(b)

The rejection of claims 14, 19, 38, 39 and 43 under 35 U.S.C. §102(b) as being anticipated by Szoka et al. (US Patent No. 5,661,025) has been maintained. In view of the present amendments of the claims, the Applicant respectfully submits that the rejection is unwarranted, and should be withdrawn.

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). "[T]he examiner **must provide some evidence or scientific reasoning** to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art" before an "applicant can be put to the burdensome task of proving that the subject matter shown to be in the prior art does not possess the characteristic relied on." *Ex parte Skinner*, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986, *emphasis added*). *See also, Ex parte Whalen*, 89 USPQ2d 1078, 1083 (Bd. Pat. App. & Int. 2008) (rejection reversed where the Examiner did not provide evidence or scientific reasoning). *Accord,* the title of Section 2112(V) of the MPEP ("ONCE A REFERENCE TEACHING PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS MADE THE BASIS OF A REJECTION, AND THE EXAMINER PRESENTS EVIDENCE OR REASONING TENDING TO SHOW INHERENCY, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW THE APPLICANT TO SHOW AN UNOBVIOUS

DIFFERENCE," page 2100-48, right column, MPEP Rev. 6, September 2007, emphasis added). Notwithstanding the Examiner's assertion to the contrary (Office Action dated August 15, 2008, paragraph bridging pages 3 and 4) it is well established in case law, and clearly stated in MPEP section 2112, that the burden of proof does not shift to the Applicant until the Examiner has presented evidence or reasoning that must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. No such evidence nor reasoning has been presented by the Examiner, only the conclusory statement that "[a]bsent evidence to the contrary, the molecules taught by Szoka et al. are capable of mediating RNAi." (Office Action dated February 26, 2008, page 4, third paragraph). The Applicant respectfully maintains that the rejection of claims 14, 19, 38, 39 and 43 under 35 U.S.C. §102(b) as being anticipated by Szoka et al. (US Patent No. 5,661,025) is unwarranted, and should be withdrawn.

Claim Rejections* - 35 *USC* § *103

The rejection of claims 14, 19-28, 30 and 33-44 under 35 U.S.C. §103(a) as being unpatentable over Sato et al. (Clinical Cancer Research 2001), Tuschl et al., McManus et al., Olejnik et al., Grigoriev et al., and evidenced by Milhem et al. (International Journal of Pharmaceutics 2000, Vol. 197: 239-241) has been maintained. The Applicant respectfully submits that this rejection is unwarranted in view of the present amendments to the claims, and should be withdrawn.

Sato et al. disclose that a ^{111}In labeled antisense oligonucleotide complexed with either to a G4 PAMAM dendrimer or a biotinylated G4 PAMAM dendrimer can be delivered to tumor cells both *in vitro* and *in vivo* by non-sequence-specific targeting (page 3611, right column). The Sato et al. reference does not disclose evidence of effective RNA interference or the delivery of siRNA. The Milhem et al., reference discloses the use of G4 PAMAM dendrimers to improve the solubility of ibuprofen, but does not disclose or suggest the use of G4 PAMAM dendrimers with an amount of a nucleic acid effective to mediate RNA interference. The teachings of Tuschl et al., McManus et al., Olejnik et al., and Grigoriev et al.,. in combination have been discussed in previous responses. The combination of Sato et al., Tuschl et al., McManus et al., Olejnik et al., Grigoriev et al., and Milhem et al. neither teaches nor makes obvious the presently claimed invention as a whole at the time that the invention was made.

Conclusion

In light of the amendments and the remarks presented herein, the Applicant respectfully submits that all pending claims are in condition for allowance and requests a timely Notice of Allowance to follow in this case. The Applicant requests that the Examiner telephone the undersigned at (508) 860-1472 in the event that a telephone discussion would be helpful in advancing the prosecution of the present case.

A Request for Continued Examination and a petition for a three-month extension of time and the required fees are submitted herewith. It is believed that no additional fees or extensions of time are required. In the event any additional extensions of time are necessary, please consider this a petition therefor. In the event any fees or credits are due, the undersigned hereby authorizes the fees or credits to be charged to Deposit Account No. 50-1582.

Respectfully submitted,

February 13, 2009

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By _____

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